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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kenneth E. Flick

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EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5/1

Office Action Summary	Application No. 09/993,930	Applicant(s) FLICK, KENNETH E.	
	Examiner Matsuichiro Shimizu	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS; WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21, 23-34, 36-44 and 46-71 is/are rejected.
- 7) ☒ Claim(s) 10, 22, 35 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The examiner withdraws rejection of claims 1, 13, 24, 29 and 34 in view of applicant's removal of functional recitation "to thereby alert a user of a potentially unauthorized learned remote transmitter".

Response to Arguments

Applicant's arguments filed on 9/5/06 have been fully considered and examiner's response is provided as follows:

Regarding applicant's argument (lines 16-20, page 18) that "alert a user of a potentially unauthorized learned remote transmitter" in method claims 48 and 60 is not explanation functional language or has patentable weight, the examiner maintains that any intended use limitation, even in a method claim, must result in a structural difference between the prior art and the invention. Once we have teaching of "indicating" that a new remote has been learned, then it can be applied against claim limitations merely claiming the "purpose" of the indicating. Therefore, "alert a user of a potentially unauthorized learned remote transmitter" cited in claims 48 and 60 has no patentable weight.

Regarding applicant's argument (lines 4-12, page 21) that Heitschel does disclose extending transmitter time, Lavelle disclose LED comes on when new key is added or leaned programming mode (see Heitschel-24, page 15).

In response to applicant's argument (lines 4-12, page 21) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lavelle discloses LED

indicates when code of key is added to the controller (col. 6, lines 14–23, LED is on when key or code transferring transmitter has been changed or learned), and Heitschel discloses transmitter (Fig. 1, transmitters 26 and 27) is associated with Lavelle's key. One skilled in the art recognizes that once you see LED, then you do not reprogram the controller by using transmitter, and thus saving battery life time of transmitter. Therefore, Heitschel and Lavelle are combinable to disclose LED on when transmitter code is added to the controller as claimed in claim 1.

In response to applicant's argument (lines 17–22, page 21) that Heitschel in view of Lavelle does not disclose controller cooperating with the at least one indicator for indicating whether a new uniquely coded remote transmitter has been learned based upon the controller being switched to the door moving mode, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the examiner maintains that Heitschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41–59, unique code in transmitter 23), and Lavelle teaches, in the art of access door system, upon transmission code by the key in the receptor 60 (Fig. 2), one indicator for indicating whether a new uniquely coded remote transmitter has been learned (col. 6, lines 14–23, LED notification), and entry is completed while the key is in. One skilled in the art recognizes that indicator light LED continues to lit after learned and normal is performed for moving the entry door. Therefore, Heitschel in view of Lavelle does disclose controller cooperating with the at least one indicator for indicating whether a new uniquely coded remote transmitter has been learned based upon the controller being switched to the door moving mode.

In response to applicant's argument (lines 5–8, page 22) that Heitschel in view of Lavelle does not disclose controller cooperating with the at least one

indicator for indicating whether a new uniquely coded remote transmitter has been learned, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the examiner maintains that Heitschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41–59, unique code in transmitter 23), and Lavelle teaches, in the art of access door system, upon transmission code by the key in the receptor 60 (Fig. 2), one indicator for indicating whether a new uniquely coded remote transmitter has been learned (col. 6, lines 14–23, LED notification associated with change of key suggests new key also). One skilled in the art recognizes notification associated with change of key suggests new key also.

In response to applicant's argument (lines 1–5, page 23) that Heitschel in view of Lavelle does not disclose continuous indication of whether a new uniquely coded remote transmitter has been learned, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the examiner maintains that Heitschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41–59, unique code in transmitter 23), and Lavelle teaches, in the art of access door system, one indicator for indicating whether a new uniquely coded remote transmitter has been learned (col. 6, lines 14–23, LED notification associated with change of key suggests new key also). Therefore, one skilled in the art recognizes continuous indication of light or LED code is suggested by LED on (col. 16–20, page 6).

In response to applicant's argument (lines 11–18, page 23) that Heitschel in view of Lavelle does not disclose one indicator for repeatedly indicating whether a new uniquely coded remote transmitter has been learned, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the examiner maintains that Heitschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41–59, unique code in transmitter 23), and Lavelle discloses, in the art of access door system, one indicator for indicating whether a new uniquely coded remote transmitter has been learned (col. 6, lines 14–23, LED notification associated with change of key). Therefore, one skilled in the art recognizes repeated indication of light or correct LED code is suggested by visual LED on (col. 6, lines 16–20).

In response to applicant's argument (lines 24–26, page 23) that Heitschel in view of Lavelle does not disclose one indicator for indicating that the learning mode has recently been exited, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the examiner maintains that Heitschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41–59, unique code in transmitter 23), and Lavelle discloses, in the art of access door system, one indicator for indicating that the learning mode has LED notification associated with change of key (col. 6, lines 14–23, LED notification associated with change of key). Therefore, one skilled in the art recognizes one indicator for indicating that the learning mode has recently been exited is suggested by visual LED Notification.

Therefore, rejection of claims 1-9, 11-21, 23-34, 36-44 and 46-71 follows:

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12-21, 23-34, 36-44, 47-57, 59-69 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heistschel et al. (RE. 35,364) in view of Lavelle et al. (5,815,084).

Regarding claims 1, 13, 24, 29 and 34 Heistschel discloses unique code of transmitter 26 (Fig. 1, col. 3, lines 41-59, unique code in transmitter 23) is transmitted while this code is received as switch is on program mode 19 and code receiving address in memory is switched to 4 (Fig. 2, switch 23). Upon completion of learning, switch 22 is immediately placed on operate mode to move the garage door (Fig. 1, col. 3, lines 41-59, moving garage door 17).

But Heistschel is silent on one indicator for indicating immediately whether a new uniquely coded remote transmitter has been learned.

However, Lavelle teaches, in the art of access door system, one indicator for indicating whether a new uniquely coded remote transmitter has

been learned (col. 6, lines 14-23, LED notification) for the purpose providing notification to extend transmitter life time.

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to have included in Heistschel the features of Lavelle just discussed above because LED notification feature prevents unnecessary transmitter operation, thus extending transmitter life time.

Regarding claims 2, 14, 25, 30 and 38, Heistschel teaches last increment position of switch 23 indicating number of learned remote transmitter while the switch 22 is in program mode (Fig. 2, switch in fourth leaned transmitter).

Regarding claims 3, 15 and 39, Lavelle teaches one indicator for indicating a change (col. 6, lines 14-23, adding or deleting key id 20 is analogous to changed number of authorized keys in the controller and is notified to the LED) in a number of learned remote transmitters.

Regarding claims 4, 16 and 40, Lavelle teaches one indicator (Lavelle- Fig. 11, col. 6, lines 14-23, LED notification for adding new code of the attached key 20 by depressing 3-4 key) for indicating a change in a unique code (Fig. 11, col. 6, lines 14-23, LED notification for adding new code of the attached key 20 by depressing 3-4 key) of learned remote transmitters.

Regarding claims 5, 17, 26, 31 and 36, Lavelle continues, as claimed in claim 1, to teach indicator comprises a light (col. 6, lines 14-23, LED notification).

Regarding claims 6, 18, 27, 32 and 41, Heistschel teaches a remote

door switch 22 (Fig. 1, col. 3, lines 41–59, moving garage door 17) for switching said controller to the door moving mode.

Regarding claims 7, 37 and 42, Lavelle continues, as claimed in claim 1, to teach a remote indicator switch (Fig. 11, col. 6, lines 14–23, LED notification for adding new code of the attached key 20 by depressing 3–4 key) for causing said controller to cooperate with said at least one indicator for indicating whether a new uniquely coded remote transmitter has been learned.

Regarding claims 8, 19–20 and 43, Heistschel in view of Lavelle teaches a remote control system according to claim 1 further comprising: at least one light (Lavelle – Fig. 11, col. 6, lines 14–23, LED notification) connected to said controller and being energized when said controller is switched to the door moving mode (Heistschel– Fig. 1, col. 3, lines 41–59, moving garage door 17); and a remote light switch for also causing said at least one light to be energized, and for causing said controller to cooperate with said at least one indicator for indicating (Lavelle– Fig. 11, col. 6, lines 14–23, LED notification) whether a new uniquely coded remote transmitter has been learned.

Regarding claims 9, 21 and 44, Lavelle teaches a learned transmitter indicator switch for causing said controller for indicating whether a new uniquely coded remote transmitter has been learned (Figs. 1 and 11, col. 6, lines 14–23, LED 24 notification on reader 12 for adding new code of the attached key 20 by depressing 3–4 key).

Regarding claims 12, 23, 28, 33 and 47, Heistschel teaches a remote control system according to claim 1 wherein the access door comprises a garage door (Fig. 1, col. 3, lines 41–59, moving garage door 17).

All subject matters except to thereby alert a user of a potentially unauthorized learned remote transmitter in claim 48 are discussed above with regards to claim 1. However, in view of the reason provided in the first paragraph of argument (lines 16–20, page 18) the above phrase does not have patentable weight, and therefore rejection of the subject matters expressed in claim 48 are met by references applied to rejection of claim 1.

All subject matters in claims 49–55 and 59 are discussed above with regards to claims 2–8 and 12, and therefore rejection of the subject matters expressed in claims 49–55 and 59 are met by references and associated arguments applied to rejection of claims 2–8 and 12.

All subject matters in claims 56–57 are discussed above with regards to claims 9–10, and therefore rejection of the subject matters expressed in claims 56–57 are met by references and associated arguments applied to rejection of claims 9–10.

All subject matters except to thereby alert a user of a potentially unauthorized learned remote transmitter in claim 60 are discussed above with regards to claim 13. However, in view of the reason provided in the first paragraph of argument (lines 16–20, page 18) the above phrase does not have

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patentable weight, and therefore rejection of the subject matters expressed in claim 60 are met by references applied to rejection of claim 13.

All subject matters in claims 61–67 and 71 are discussed above with regards to claims 14–20 and 23, and therefore rejection of the subject matters expressed in claims 61–67 and 71 are met by references and associated arguments applied to rejection of claims 14–20 and 23.

All subject matters in claims 68–69 are discussed above with regards to claims 21–22, and therefore rejection of the subject matters expressed in claims 68–69 are met by references and associated arguments applied to rejection of claims 21–22.

Claims 11, 46, 58 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heistschel in view of Lavelle as applied to claim 1, 34, 48 and 60 above, and further in view of Soenen et al. (6,046,680).

Regarding claims 11, 46, 58 and 70, Heistschel in view of Lavelle does not teach the learned remote transmitter transmits a pseudo-randomly coded signal to said controller.

However, Soenen teaches, in the art access system, the learned remote transmitter transmits a pseudo-randomly coded signal to said controller (col. 12, lines 4–6, random code generator 36a) for the purpose of providing high level of security. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include the learned remote transmitter transmits a pseudo-randomly coded signal to said controller in the

claimed device of Heistschel in view of Lavelle because Heistschel in view of Lavelle suggests uniquely coded remote transmitter and Soenen teaches the learned remote transmitter transmits a pseudo-randomly coded signal to said controller for the purpose of providing high level of security.

Allowable Subject Matter

Claims 10, 22, 35 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 10, 22 and 45, the prior arts fail to teach or fairly suggest one uniquely coded remote transmitter comprises a remote transceiver and a remote indicator associated therewith so that selection of said learned transmitter indicator switch causes said controller to cooperate with said remote indicator via said fixed and remote transceivers for indicating whether a new uniquely coded remote transmitter has been learned.

Regarding claim 35, the prior arts fail to teach or fairly suggest one indicator progressively indicates a passage of time since the learning mode has been exited.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See

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MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is 571-272-3066. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber, can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3068.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu
November 15, 2006

MS

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